



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 3624
Examiner: Mr. Daniel S. Felten

In re PATENT APPLICATION of:

| | | | |
|---------------|---|---|--------------------------|
| Applicant | : | Kazunori SUZUKI et al |) |
| Serial No. | : | 09/899,818 |) |
| Filed | : | July 9, 2001 |) RESUBMISSION OF |
| For | : | RELAY SERVER, RELAYING METHOD AND PAYMENT SYSTEM | REQUEST) |
| Attorney Ref. | : | SAT 163 |) |

July 19, 2005

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The courtesy extended by the Examiner to Applicants' attorney during a telephone conversation on July 18, 2005 is noted with appreciation. Applicants' attorney telephoned the Examiner to inquire whether the Examiner had considered Applicants' request to withdraw or modify requirements for information that were set forth in the Office Action dated May 19, 2005. After checking a computer database, the Examiner advised that this request was not present.

It would appear that the request may have gone astray at the Patent and Trademark Office. Accordingly, a copy of the request (entitled "Request to Withdraw or Modify Requirements for Information") is attached, along with a postcard filing receipt showing that it was originally filed on June 23, 2005. If the request has indeed been misplaced at the

ENCLOSURE
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No. 18-0002

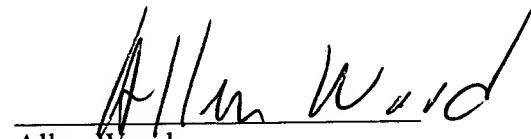
RESUBMISSION OF REQUEST

09/899,818

Patent and Trademark Office, it is respectfully requested that the attached copy be considered in lieu of the original.

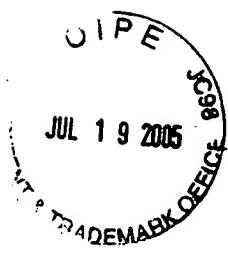
Expedited consideration is respectfully requested, since the due-date for response that was set in the Office Action of May 19 was today, July 19, 2005.

Respectfully submitted,



Allen Wood
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Customer No. 23995
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AW:rw



RECEIPT NO. 21543 DATE: 23 June 2005
ATTY. POCKET: SAT 163

APPLICANT(S): KAZUHIRO SUZUKI et al
U.S. APPLICATION NO.: 09/899,818
FILED: 11/16/2001

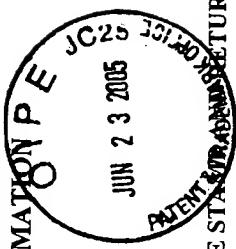
FILED: July 9, 2001
FQB: BELLAY SERVFB

RELAY SERVER, RELAYING METHOD AND PAYMENT SYSTEM

PAPERS FILED:

1) REQUEST TO WITHDRAW OR MODIFY REQUIREMENTS FOR INFORMATION P

Fee: \$0.00



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Group Art Unit: 3624
Examiner: Mr. Daniel S. Felten

In re PATENT APPLICATION of:

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|---------------|---|---|---|----------------------------|
| Applicant | : | Kazunori SUZUKI et al |) | |
| Serial No. | : | 09/899,818 |) | REQUEST TO WITHDRAW |
| Filed | : | July 9, 2001 |) | OR MODIFY |
| For | : | RELAY SERVER, RELAYING METHOD AND PAYMENT SYSTEM |) | REQUIREMENTS FOR |
| Attorney Ref. | : | SAT 163 |) | <u>INFORMATION</u> |

June 23, 2005

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Communication dated May 19, 2005 has been received. It imposes requirements for information under 37 CFR 1.105. For the reasons discussed below, it is respectfully submitted that the requirements for information should be withdrawn entirely, or at least the requirement in section 1(1) of the Office Communication should be further limited in scope. It is also respectfully requested that Applicants be informed of the reason or reasons why this information is being required.

(A) Why Is This Information Being Required?

37 CFR 1.105(a)(1) permits an Examiner to require submission "of such information as may be reasonably necessary to properly examine or treat the matter ...". It is respectfully submitted that Applicants are entitled to know exactly what is "the matter" that is under consideration. Is the required information being sought to help the Examiner determine whether the claims are patentable over the prior art, or for some other purpose?

(B) The Requirements For Information Should Be Withdrawn

Section 704.14 of the MPEP acknowledges that a requirement for information is

a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

The burden of collecting the information required in section 1(1) of the Office Communication ("A copy of any non-patent literature, published application, or patent ... that relates to the claimed invention that was used in the invention process ...") is particularly severe in the present case since the inventors are Japanese, and undoubtedly relied most heavily on publications that were written in the Japanese language. When the broad requirement for information in section 1(1) of the Office Communication is considered in conjunction with the request in the Office Communication for "a concise explanation of the reliance placed on" each publication "in the development of the disclosed subject matter," it will be apparent that the burden of complying with the requirement will be a severe one.

Section 704.11 of the MPEP advises that a requirement for information should only be made “when the examiner has a reasonable basis for requiring information.” The same section of the MPEP indicates that a prime situation in which information may be reasonably necessary is when relevant prior art is difficult for the Examiner to locate. This is not the case in the present application, though, since an Office Action dated August 11, 2004 rejected the claims on the prior art. While it is acknowledged that this does not necessarily preclude a requirement for information (see MPEP section 704.11(b)), it does weigh against imposing such a requirement at this stage. Information for helping to find prior art cannot truly be said to be “reasonably necessary” if the Examiner has already found relevant prior art, particularly since the inventors have a duty anyway to disclose material prior art that they know about. Indeed, the “Background of the Invention” section mentions two U.S. patent applications that are presumably available to the Examiner.

Section 704.10 of the MPEP permits a requirement for reasonably necessary information to be made “in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports.” If the Examiner continues to be of the opinion that the information required in of the Office Communication is reasonably necessary, it is respectfully requested that a copy of such policies or a summary of such practices be supplied so that Applicants can verify that the information required by the Office Communication is truly of the type that is deemed to be reasonably necessary in this Technology Center.

**(C) If The Requirements For Information Are Not Withdrawn,
The Requirement in Section 1(1) Should At Least Be Limited**

First, it is not entirely clear what is being required in section 1(1) of the Office Communication of May 19, 2005. The first sentence of this section requires “A copy of any non-patent literature, published application, or patent (US or foreign), by any of the inventors, that relates to the claimed invention that was used in the invention process ...” (emphasis added). The next sentence, though, asks for “the title, citation and copy of *each* publication that [any] of the applicants relied on to develop the disclosed subject matter ...”. Is it the inventors’ own prior publications that are sought if they relied on these prior publications during the invention process, or is it any publications?

It should be noted that responding to the requirement in section 1(1) of the Office Communication would be considerably less burdensome if the requirement is limited to the inventors’ own publications, since the inventors could then identify their own publications and select those that seem pertinent to the present application. A requirement for any publication on which the inventors relied on to develop the subject matter disclosed in the present application, on the other hand, might arguably extend to half-remembered textbooks in college engineering or economics classes. It seems likely that the inventors have studied network communications and banking transactions for a considerable period of time, and have accumulated in their minds a body of knowledge whose original sources might be difficult to recollect. And because the requirement section 1(1) of the Office Communication appears to go beyond the inventors’ duty to disclose material prior art under 37 CFR 1.56, it can be expected to become a fruitful source of discord, if infringement litigation ever

becomes necessary, unless the inventors can readily identify what publications come within the purview of the requirement.

The second sentence of section 1(1) of the Office Communication specifies “*each* publication that [any] of the applicants relied upon to develop the disclosed subject matter that describes the [applicants’] invention, particularly as to developing the features of ...” claim 1 (with minor errors that are not significant here). Claim 1 recites a number of elements, including a network, a user terminal, a shop server, a payment server, and so forth. It is respectfully submitted that requiring each publication that the inventors relied on regarding these elements is excessive. Section 704.14 of the MPEP states that a requirement for information “should be narrowly specified and limited in scope.” As presently formulated, the requirement in section 1(1) of the Office Communication is not narrowly specified, and its scope is uncertain but could certainly not be described as limited.

If the Examiner persists in the requirement for information in section 1(1) of the Office Communication, it is respectfully requested that the requirement be re-formulated so as to focus on whatever information is truly considered to be important. Simply referring to the recitations of claim 1 is entirely too broad a requirement

For example, if the Examiner’s concern lies with some particular element specified in claim 1 or with some particular relationship that is recited in claim 1 between elements, please limit the requirement to that element (or elements) or relationship (or relationships). If the Examiner’s concern is more general in nature, such as background information about electronic payment processing, perhaps the requirement might be limited to some specified number (a small one, such as five or ten) prior art publications in the English language

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REQUIREMENTS FOR INFORMATION

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describing electronic payment processing schemes having elements in common with the present invention (if, indeed, the inventors are aware of five or ten English language publications of this nature). Depending upon how the requirement for information is re-defined, it might also be useful to further identify the information that is being required by limiting it in time (for example, documents that the inventors know about and that were published in the year 2000 or later).

Conclusion

For the foregoing reasons, it is respectfully submitted that the requirements for information in the Office Communication dated May 19, 2005 should be withdrawn, or that the requirement in section 1(1) should at least be limited (and the period for responding should be restarted). It is also respectfully requested that Applicants be advised if the purpose of any of the four requirements for information in the Office Communication dated May 19, 2005 is anything other than ascertaining patentability of the claims over the prior art.

Respectfully submitted,



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